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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/747,529	12/22/2000	James M. Sheppard JR.	2827	2077
7590 10/31/2007 DOUGHERTY & CLEMENTS & Hofer Suite 300 1901 Roxborough Road Charlotte, NC 28210			EXAMINER JOHNSON, JENNA LEIGH	
			ART UNIT 1794	PAPER NUMBER
			MAIL DATE 10/31/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

09/747,529

**Applicant(s)**

SHEPPARD, JAMES M.

**Examiner**

Jenna-Leigh Johnson

**Art Unit**

1794

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 28 August 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 21, 22, 24-30 and 32-36 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 21, 22, 24-30 and 32-36 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/C)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date \_\_\_\_\_

### **DETAILED ACTION**

1. In view of the response filed under 37 CFR 1.111 on August 28, 2007, requesting that prosecution be reopened since the Examiner's Answer included a new grounds of rejection. PROSECUTION IS HEREBY REOPENED.

2. The amendment filed on August 28, 2007 has been entered. Claims 1 – 20, 23, and 31 are cancelled. Claims 24 and 25 have been amended. Claims 21, 22, 24 – 30, and 32 – 36 are pending.

#### ***Claim Rejections - 35 USC § 103***

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

4. Claims 21, 22, 24 – 30, and 32 – 36 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Stark in view of Parker et al. for the reasons of record.

5. Claims 21, 22, 24 – 30, and 32 – 36 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Parker et al. in view of Stark for the reasons of record.

6. Claims 21, 22, 24 – 30, and 32 – 36 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Stark and Parker et al., as set forth above, and in further view of Sherrill et al. for the reasons of record.

7. Claims 21, 22, 24 – 27, 29, 30, 32 – 34, and 36 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Terrasse in view of Stark for the reasons of record.

8. Claims 21, 22, 24 – 30, and 32 – 36 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Parker et al. and Stark, as set forth above, and in further view of Terrasse for the reasons of record.

#### ***Response to Arguments***

9. Applicant's arguments filed August 28, 2007 have been fully considered but they are not persuasive. The applicant argues that Terrasse only teaches applying decoration or embellishments by weaving a design in the central area and does not teach printing a design in the central area (response, page 6). The examiner agrees that while Terrasse does teach adding decorations to the central area, Terrasse only teaches that these decorations are added by weaving. The rejection does not state that Terrasse teaches printing. Instead Stark

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is relied on to teach applying a printed design onto woven patterned fabrics either in or out of registry. The applicant argues that since Stark is drawn to a woven patterned fabric with varying pile heights combined with a printed floral design that overlies that the woven patterned fabric, and not a smooth patterned fabric as disclosed by Terrasse, one of ordinary skill in the art would not appreciate that a printed pattern could be applied to smooth woven pattern fabrics. However, Stark teaches that the fabric can be made by various techniques and just requires that the construction of the fabric be varied in some manner to create a pattern. The goal of Stark is directed to combining printed design patterns with woven patterned fabrics to create various desired visual appearances in the finished product. Hence, one of ordinary skill in the art would appreciate that the printed pattern disclosed by Stark could be applied to patterned fabrics with or without varying height since printed designs are known to be applied to various types of fabrics. Thus, it would have been obvious to one having ordinary skill in the to apply further decorate or embellish by printing, as taught by Stark, onto the woven patterned fabric disclosed by Terrasse since Stark teaches printing is a method to apply decorations and embellishments to a patterned fabric and Terrasse teaches that decorations and embellishments are desired in the central area.

Further, as shown by the prior art, all the claimed elements, i.e., woven patterned fabrics with borders and printing pile and patterned fabrics, were known in the prior art and one of ordinary skill in the art would have combined the elements as claimed by known methods with no change in their respective functions, and the combination would have yielded predictable results to one of ordinary skill in the art at the time of the invention. And the technique for improving a particular product, i.e., printing desired designs, was part of the ordinary capabilities of person of ordinary skill in the art, in view of the teaching of the technique for improvement in other situations. Finally, the claim would have been obvious because design incentives provides a reason to make an adaptation, i.e., to create desired visual appearances, and the invention resulted from application of the prior knowledge in a predictable manner. Thus, the rejection is maintained.

10. The applicant also argues that the prior art fails specifically teach the ability to mask printing colors if the print design overlaps the border regions (response, page 6). However it is noted that this limitation is not positively recited by the applicant. First, the claim states that the graphic impression *may* overlap the border. The image is not required to overlap the border region and Stark teaches that the print can be applied in registry with the woven pattern. Thus, the printed image would not be in the border region and the border would not have any printing to mask. And the features of the claim are met by the combination of Terrasse and Stark.

Second, the applicant recites that the regions have two colors one being a *lighter* color and one being a *darker* color. These colors are only defined relative to each other and the applicant does not require any specific color selections. Finally, the claim recites that the border is capable of masking a possible printed image and potential bleed, but does not recite any specific dye colors which need to be masked. The claim does not positively state the border is printed or the print has bled through the fabric. It has been held that the recitation that an element is “capable of” performing a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138. Further, the light or darker colors inherently have the ability to mask some colors. And even if a color does not mask many colors it will at least mask a print color which is identical or very similar in color to the fabric colors, i.e., white would mask white. Therefore, the different colored fabric sections inherently have the ability to mask some colors and meets the recited limitation that the different colored sections are capable of masking printing colors. Further, it is noted that no color would be able to mask every possible printed color. Even a dark color like black would not be able to mask light colors like white. Thus, the claimed lighter and darker colors would only have the capability of masking some colors, which is inherently true for all colors. And, as noted previously, the applicant is not claiming that borders are specific colors or that the print is specific colors, or even that the borders are positively printed or that the borders positively mask specific colors. The claim only requires that regions adjacent to and opposite from the

printed central area have the ability to mask some colors, which would be true no matter what colors are chosen. Therefore, the rejection is maintained.

11. The applicant also argues that rejection over Parker et al., Stark, and Terrasse that there is no suggestion to apply a printed pattern to the woven patterned fabric disclosed by Parker et al. or Terrasse (response, page 7). As set forth above, Stark discloses the desirability of combining printed designs and woven designs to create various visual appearances in the end product. Stark does not exclude the printed patterns from being applied to flat patterned woven fabrics and it is well known that printed patterns can be applied to various types of patterned fabrics. One of ordinary skill in the art would be motivated to apply a printed design to any woven patterned fabric to create various appealing end product designs, as discussed above.

Further, as shown by the prior art, all the claimed elements, i.e., woven patterned fabrics with borders and printing pile and patterned fabrics, were known in the prior art and one of ordinary skill in the art would have combined the elements as claimed by known methods with no change in their respective functions, and the combination would have yielded predictable results to one of ordinary skill in the art at the time of the invention. And the technique for improving a particular product, i.e., printing desired designs, was part of the ordinary capabilities of person of ordinary skill in the art, in view of the teaching of the technique for improvement in other situations. Finally, the claim would have been obvious because design incentives provides a reason to make an adaptation, i.e., to create desired visual appearances, and the invention resulted from application of the prior knowledge in a predictable manner. Thus, the rejection is maintained.

12. Additionally, the applicant argues that the rejection fails to suggest the masking capability of the border regions, or the central area on the backside (response, page 7). However, as set forth above, the applicant does not positively recite that the printed pattern overlaps onto the border or that the printed pattern bleeds through to the back of the fabric. Thus, the limitations argues by the applicant are not positively recited, but only require the ability to mask some colors. Further, it is noted that the rejection combined the

features of Stark, Parker et al., and Terrasse. And as discussed in the previous rejections and above, the fabrics taught by Parker et al. and Terrasse teach using multi-colored fabrics which have lighter colors and darker colors. These disclosed lighter or darker colors would inherently have the ability to mask some colors, since every color would at least be capable of masking printed colors which are the same or similar to the base color. Thus, the rejections are maintained.

13. Finally, it is noted that the applicant maintains their arguments from the Appeal Brief with regards to the remaining rejections (response, page 5). These rejections have been addressed in the Examiner's Answer mailed on June 28, 2007. For the reasons of record the rejections are maintained.

#### ***Conclusion***

14. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jenna-Leigh Johnson whose telephone number is (571) 272-1472. The examiner can normally be reached on Monday - Friday (8:00 - 5:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on (571) 272-1478. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

jlj  
October 29, 2007

/Jenna-Leigh Johnson/  
Primary Examiner  
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